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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,875	07/19/2001	Jens Ehlers	1998/G-021	8024

23416 7590 10/28/2004
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EXAMINER

RABAGO, ROBERTO

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,875

Applicant(s)

EHLERS ET AL.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Spencer et al. (US 5,633,419) for the reasons set forth in item 3 of the Office action mailed 3/22/2004.
2. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchand et al. (US 4,910,272) for the reasons set forth in item 4 of the Office action mailed 3/22/2004.
3. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Heinrich et al. (US 5,292,837) for the reasons set forth in item 5 of the Office action mailed 3/22/2004.
4. Applicant's arguments filed 8/6/2004 have been fully considered but they are not persuasive.

Applicants' traversal of all three rejections rests on essentially the same premise, i.e., that differences in the manner in which the reference catalyst was made would necessarily place such processes outside the scope of the claims. Firstly, applicants' various arguments pointing out that the reference catalysts include additional components not specified in the claims is wholly irrelevant because the instant catalyst

Art Unit: 1713

is not limited to the components specified in the claims. Furthermore, the instant claims are directed neither to catalysts nor methods of making catalysts, but rather to methods of making a polymer. The required polymer has selected properties within broad ranges, and the required catalyst includes a single limitation set forth as product-by-process. Regarding the claimed polymer properties, applicants have not traversed the prior holding that any claimed properties which have not been reported in the applied reference would be inherent. Regarding the scope of catalysts which fall within the claimed scope, it is repeated that the record includes no evidence or basis to believe that the additional contact conditions specified in the product-by-process portion of the claims (directed to the making of the catalyst) would exclude the reference ~~polymers~~ ^{catalysts} from the broad scope of the claims. Applicants are reminded of the following regarding limitations set forth as product-by-process (i.e., the catalyst of the instant claims):

PR
10/22/04

MPEP 2113:

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Each of the references discloses a method of olefin polymerization comprising the use of a catalyst made by contacting a Ti(IV) compound with an organoaluminum compound in a solvent, furthermore disclosing polymers wherein all of the specifically reported properties are within the scope of polymer properties required in the claims. However, aside from identifying selected aspects wherein the overall reference methods differ from those described in the instant specification, applicants have provided nothing

which would provide any basis to conclude that the reference catalysts would be outside the scope of all catalysts which include the following method step in their production:

reacting a Ti(IV) compound with an organic aluminum compound at from -20°C to 50°C in a suspension medium for from 0.5 minute to 60 minutes.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

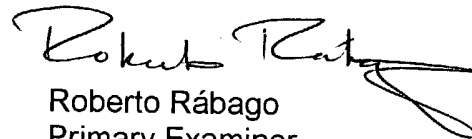
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Roberto Rábago", with a stylized flourish extending from the end.

Roberto Rábago
Primary Examiner
Art Unit 1713

RR
October 22, 2004